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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,219	04/09/2001	Jacob Leidner	209391	9737

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

10

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/828,219

Applicant(s)

LEIDNER ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2003 and 21 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10,22-41 and 69-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,8,22-41 and 69-91 is/are rejected.
- 7) ☒ Claim(s) 5-7,9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding rejection and objections except for those described below are overcome by applicants' amendment filed 1/3/03 and declaration filed 1/21/03. Further, the statutory double patenting rejection of record is withdrawn in light of the cancellation of claims 11-19 while the non-statutory double patenting rejection of record is withdrawn in light of applicants' filing of a terminal disclaimer on 1/3/03.

The following rejection is non-final in light of the new grounds of rejection as set forth in paragraphs 2-3 below as well as the use of a new reference against the present claims, namely, Kitazawa (U.S. 5,595,700) and the new grounds of rejection as set forth with respect to JP 02036281.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 22-41 and 73-91 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 22 and 73 each disclose composition "which is capable of forming a cohesive layer". However, "capable of" is not a positive limitation, it only requires the ability to so perform. *In re Hutchinson* 69 USPQ 138. The scope of the claim is confusing because it is not clear if the composition actually forms a cohesive layer when applied to a surface or if the

composition must only have the ability to do so. It is suggested that the above phrase be re-written as “which forms a cohesive layer”.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 22-23, 34-35, 37, 40-41, 69-74, 85, 87, and 90-91 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitazawa (U.S. 5,595,700).

Kitazawa discloses method of using an erasable colored pencil lead composition that is used to draw lines on paper. The composition comprises filler, colorant, binder, and polytetrafluoroethylene, i.e. fibrillatable material. Further, it is noted that given that Kitazawa discloses that the composition contain oil, fat, “and/or” waxes, it is clear that the use of wax is not required (col.1, lines 15-18, col.2, line 46-col.3, line 60, col.4, lines 33-36 and Table 1).

Although there is no explicit disclosure that the erasable colored pencil lead of Kitazawa forms a cohesive layer, given that Kitazawa discloses that the pencil lead is erasable, it is clear that the pencil lead must inherently form a cohesive layer otherwise the written mark produced by the pencil lead would not easily erase from substrate as disclosed by Kitazawa (Table 1).

Further, although Kitazawa is silent with respect to erasability, smear rate, and smudge rate of the erasable colored pencil lead composition, given that Kitazawa discloses composition

identical to that presently claimed, i.e. comprising filler, binder, colorant, and fibrillatable material, it is clear that the composition would intrinsically possess erasability, smear rate, and smudge rate as presently claimed.

In light of the above, it is clear that Kitazawa anticipates the present claims.

6. Claims 22-24, 35-41, 69-75, 86, and 90-91 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 02036281.

JP 02036281 discloses method for using an erasable colored pencil lead by applying the lead to paper in order to create a mark wherein the erasable colored pencil lead comprises polyethylene binder, fibrillatable ethylene-vinyl acetate copolymer, lubricant, filler, and colorant and wherein the mark is erasable by an eraser (claim 1, paragraph bridging pages 1-2, page 3, first full paragraph, page 4, lines 2-6, and page 7, lines 4-6).

Although JP 02036281 is silent with respect to erasability, smear rate, and smudge rate of the erasable colored pencil lead composition, given that JP 02036281 discloses composition comprising fibrillatable material and lubricant as presently claimed which both enhance the erasability of the composition, it is clear that the composition would inherently possess erasability, smear rate, and smudge rate as presently claimed.

Further, there is no explicit disclosure that the erasable colored pencil lead produces a cohesive layer. However, given that JP 02036281 discloses that the written mark has sufficient strength against damage, abrasion resistance, and improved erasability and further given that JP 02036281 discloses composition as presently claimed, it is clear that the erasable colored lead composition of JP 02036281 inherently forms a cohesive layer as presently claimed.

In light of the above, it is clear that JP 02036281 anticipates the present claims.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 24-25, 27-32, 75-76, and 78-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitazawa (U.S. 5,595,700) in view of either JP 03153778 or Grossman et al. (U.S. 4,371,632).

The disclosure with respect to Kitazawa in paragraph 5 is incorporated here by reference.

The difference between Kitazawa and the present claimed invention is the requirement in the claims of lubricant.

JP 03153778, which is drawn to colored pencils, discloses the use of polyethylene glycol lubricant in order to obtain a pencil with excellent writability and durability (page 2, last paragraph and page 4, second full paragraph).

Alternatively, Grossman et al., which is drawn to pencil leads, discloses the use of lubricants such as polyethylene glycol in order to enhance writing smoothness (col.5, lines 30-33 and col.6, lines 28-29 and 44-45).

Although neither of the above references explicitly discloses that the lubricant forms a separate domain from the binder, given that the reference lubricant is identical to that presently claimed, it is natural to infer that the reference lubricant will also function so as to form a separate domain as presently claimed.

In light of the motivation for using polyethylene glycol lubricant disclosed by either JP03153778 or Grossman et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such lubricant in the erasable colored pencil lead of Kitazawa in order to produce a pencil lead that has excellent writability and durability, or alternatively, writing smoothness, and thereby arrive at the claimed invention.

9. Claims 33 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitazawa (U.S. 5,595,700) in view of Koyama (U.S. 5,716,434).

The disclosure with respect to Kitazawa in paragraph 5 is incorporated here by reference.

The difference between Kitazawa and the present claimed invention is the requirement in the claims of antioxidant.

Koyama, which is drawn to pencil leads, discloses the use of antioxidant in order to improve the preservability of the pencil lead (col.3, lines 25-26).

In light of the motivation for using antioxidant disclosed by Koyama as described above, it therefore would have been obvious to one of ordinary skill in the art to use such antioxidant in the erasable colored pencil lead of Kitazawa in order to produce a pencil with improved preservability, and thereby arrive at the claimed invention.

10. Claims 25-32, 76-83, and 87-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02036281 in view of either JP 03153778 or Grossman et al. (U.S. 4,371,632).

The disclosure with respect to JP 02036281 in paragraph 6 above is incorporated here by reference.

The difference between JP 02036281 and the present claimed invention is the requirement in the claims of specific type of lubricant.

JP 03153778, which is drawn to colored pencils, discloses the use of polyethylene glycol lubricant in order to obtain a pencil with excellent writability and durability (page 2, last paragraph and page 4, second full paragraph).

Alternatively, Grossman et al., which is drawn to pencil leads, discloses the use of lubricants such as polyethylene glycol in order to enhance writing smoothness (col.5, lines 30-33 and col.6, lines 28-29 and 44-45).

Although neither of the above references explicitly discloses that the lubricant forms a separate domain from the binder, given that the reference lubricant is identical to that presently claimed, it is natural to infer that the reference lubricant will also function so as to form a separate domain as presently claimed.

In light of the motivation for using polyethylene glycol lubricant disclosed by either JP 03153778 or Grossman et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use such lubricant in the erasable colored pencil lead of JP 02036281 in order to produce a pencil lead that has excellent writability and durability, or alternatively, writing smoothness, and thereby arrive at the claimed invention.

11. Claims 33 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 02036281 in view of Koyama (U. S. 5,716,434).

The disclosure with respect to JP 02036281 in paragraph 6 above is incorporated here by reference.

The difference between JP 02036281 and the present claimed invention is the requirement in the claims of antioxidant.

Koyama, which is drawn to pencil leads, discloses the use of antioxidant in order to improve the preservability of the pencil lead (col.3, lines 25-26).

In light of the motivation for using antioxidant disclosed by Koyama as described above, it therefore would have been obvious to one of ordinary skill in the art to use such antioxidant in the erasable colored pencil lead of JP 02036281 in order to produce a pencil with improved preservability, and thereby arrive at the claimed invention.

12. Claims 1, 4, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitazawa (U.S. 5,595,700) in view of Koyama et al. (U.S. 5,716,434).

Kitazawa discloses method of using an erasable colored pencil lead composition that is used to draw lines on paper. The composition comprises filler, colorant, binder, and polytetrafluoroethylene, i.e. fibrillatable material. Further, it is noted that given that Kitazawa discloses that the composition contain oil, fat, "and/or" waxes, it is clear that the use of wax is not required (col.1, lines 15-18, col.2, line 46-col.3, line 60, col.4, lines 33-36 and Table 1).

The difference between Kitazawa and the present claimed invention is the requirement in the claims of antioxidant.

Koyama, which is drawn to pencil leads, discloses the use of antioxidant in order to improve the preservability of the pencil lead (col.3, lines 25-26).

In light of the motivation for using antioxidant disclosed by Koyama as described above, it therefore would have been obvious to one of ordinary skill in the art to use such antioxidant in the erasable colored pencil lead of Kitazawa in order to produce a pencil with improved preservability, and thereby arrive at the claimed invention.

Response to Arguments

13. Applicants' arguments regarding Hoshiba et al. (U.S. 5,595,589) have been considered but they are moot in view of the discontinuation of this reference against the present claims.

14. Applicants' arguments filed 1/3/03 have been fully considered, but with the exception of arguments relating to Hoshiba et al., they are not persuasive.

Applicants argue that JP 02036281 fails to disclose or suggest a composition capable of making a mark that forms a cohesive layer on the surface of substrate.

Applicants argue that JP 02036281 states that a "layered application is possible" but does not refer to a cohesive layer. It is noted that examiner has not been able to find the cited portion of JP 02036281 that discloses that a layered application is possible. Nevertheless, while it is agreed that there is no explicit disclosure in JP 02036281 that the pencil lead composition forms a cohesive layer, given that JP 02036281 discloses composition identical to that presently claimed, i.e. comprising binder, filler, fibrillatable copolymer, lubricant, and colorant, and further given that JP 02036281 discloses that a mark produced by the colored pencil lead composition is erasable, it is the examiner's position that the composition of JP 02036281 is

capable of forming a cohesive layer. If the pencil did not form a cohesive layer, the mark produced by the pencil would not exhibit strength against damage and abrasion resistance while at the same time exhibit erasability as disclosed by JP 02036281.

Further, applicants note that the composition of the present invention does form a cohesive layer and points to examples 16 and 17 and Figures 4-7 of the present specification. In examples 16 and 17, it is disclosed that it is the fibrils that are responsible for imparting cohesiveness to the composition. Thus, given that JP 02036281 discloses composition comprising fibrillatable copolymer as presently claimed, it would follow that the erasable colored pencil lead of JP 02036281 would also inherently be erasable. Further evidence to support this position is found on page 7, lines 11-24 of the present specification which is also discloses that it is the presence of the fibrillated polymer or copolymer which imparts cohesiveness to the mark formed by the colored pencil lead composition.

Applicants further argue that JP 02036281 discloses the use of low melting wax. However, it is noted that only present claims 34 and 85 require that the pencil lead be free of such waxes and that JP 02036281 is not used to reject these claims.

In light of the above, and absence evidence to the contrary, JP 02036287 remains a relevant reference against the present claims.

Allowable Subject Matter

15. Claims 5-7 and 9-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 5-7 and 9-10 would be allowable if re-written in independent form including all of the limitations of the base claim and any intervening claims for the following reasons.

Kitazawa (U.S. 5,595,700) discloses erasable colored pencil lead composition comprising filler, colorant, binder, and polytetrafluoroethylene, i.e. fibrillatable material wherein the use of wax is not required. However, there is no disclosure or suggestion that the binder is a polyolefin as required in the present claims. Further, there is no disclosure of fibrillatable or fibrillated copolymer as required in the present claims.

JP 02036281 discloses erasable colored pencil lead composition comprising polyethylene binder, fibrillatable ethylene-vinyl acetate copolymer, lubricant, filler, and colorant, however, the composition of JP 02036281 utilizes low melting waxes which is in direct contrast to the present claims which require that the composition be substantially free of such waxes.

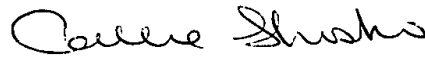
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Examiner
Art Unit 1714

CS
April 4, 2003